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PATENT APPLICATION

ATTORNEY DOCKET NO. 10011083 -1

IN THE
 UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Rajeev Grover, et al.

Confirmation No.: 4790

Application No.: 09/966620

Examiner: Brian J. Gillis

Filing Date: Sep 27, 2001

Group Art Unit: 2141

Title: Configuring A Network Parameter To A Device

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TRANSMITTAL OF REPLY BRIEF

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Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on January 24, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:
Rajeev Grover et al.

Confirmation No.: 4790

Application No.: 09/966,620

Group Art Unit: 2141

Filed: September 27, 2001

Examiner: Brian J. Gillis

For: CONFIGURING A NETWORK PARAMETER
TO A DEVICE

APPELLANT'S REPLY BRIEF (37 C.F.R. 41.41)

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer, mailed in this case on January 24, 2006. Should the Examiner not find the comments contained herein persuasive, acknowledgement of receipt and entry of this Reply Brief is requested.

The fees required under § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL REPLY BRIEF.

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This brief contains these items under the following headings:

I. Reply to the Examiner's Answer

Claims 1, 16, 19

Claims 2, 18, 21

Claim 3

Claims 5, 17, 20

Claim 6

Claim 7

Claim 9

Claim 10

Claim 4

Claims 12, 22

Claims 13, 23

Claim 14

Claim 15

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II. Conclusion

The final page of this brief bears the attorney's signature.

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I. REPLY TO THE EXAMINER'S ANSWER**Reply to Examiner's Response to Argument in the Examiner's Answer**

The Examiner's Answer, paragraph 9, page 3 to page 9, restated the grounds of rejections which were addressed in the Appeal Brief submitted on November 7, 2005. This Reply Brief mainly responds to the Examiner's Response to Argument, paragraph 10, page 9, near the middle to page 16. For a detail discussion on how the claimed inventions are distinguished from the references of records and are therefore patentable, please refer to the Appeal Brief.

Claims 1, 16, and 19**Point (A), page 9, near the bottom**

On page 9, last paragraph, the Examiner's Answer asserted that "... Philippou teaches of [sic] a box, which can be a computer system, which contains a processor. The processor, which is the first device, is embedded in the box, which is considered the second device"

It is noted that this is the first time Philippou's processor was corresponded to the claimed first device to reject the claimed invention. Additionally, the Final Office Action, the Advisory, and the Examiner's Answer were inconsistent in corresponding the claimed first device to a particular element of Philippou. The Final Office Action and the Advisory corresponded the claimed first device to Philippou's box 205 and Philippou's network interface while the Examiner's Answer corresponded the claimed first device to Philippou's processor. Regardless of the Office Actions' inconsistency, the claimed first device is patentably distinguished from Philippou' box 205, network interface, or processor.

As indicated in the Appeal Brief, page 8, near the top to page 10 first paragraph, the claimed first device is patentably distinguished from both Philippou's box 205 and network interface.

The claimed first device is also patentably distinguished from Philippou's processor. In relevant part for this discussion, claim 1 recites configuring a first parameter to a first device, and turning-off a feature to configure the first device until the first device is in an un-configured state.

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If Philippou's processor were to correspond to the claimed first device, then, to be parallel with and thus anticipate claim 1, Philippou and Ylonen, either alone or in combination, must teach configuring a first parameter to Philippou's processor and turning-off a feature to configure the processor until the processor is in an un-configured state. However, Philippou and Ylonen, do not teach such features. Even for the sake of argument that a processor is embedded in the computer system and may provide administrative capabilities for this computer system, *Philippou fails to teach configuring a parameter to the processor and turning off a feature to configure the processor or turning off a feature to configure the processor until the processor is in an un-configured state.* There is not any teaching or suggestion in Philippou regarding a configured state or un-configured state of the processor. The fact that a computer system may be used to perform many functions of box 205 in Philippou, which the Final Office Action corresponded to the claimed first device, is not patentably comparable to the claimed feature of configuring a parameter to the claimed first device or the processor.

Point (B), page 10, 2nd and 3rd paragraph

On page 10, 3rd paragraph, the Examiner's Answer asserted that "Ylonen teaches that the management station looks for new devices and if the authentication of the device is negated the device returns to a dummy state where the device reads identifiers from received packets until it receives its own configuration message (column 7, lines 1-20, column 9, lines 1-2, 44-67)." Even for the sake of argument that this assertion is true, there is nothing in this assertion that is patentably parallel to and thus anticipates the claimed limitation of turning off a feature to configure the first device or turning off the feature to configure the first device until the first device is in an un-configured state. The claimed first device being configured is patentably distinguished from whether the authentication of the device in Ylonen is negative or positive. Reading identifiers from the received packets by a device until it receives its own configuration message in Ylonen is not patentably parallel to the claimed turning off a feature to configure the first device or turning off the feature (to configure the first device) until the first device is in an un-configured state.

As indicated in the Appeal Brief, "Ylonen's cited paragraph of col. 7, lines 1-20 discloses that to configure a new network device, the management station sends a packet to the new network

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device. The packet will be addressed so that the new network device will be able to see it. In an IP network, the configuration packet can be addressed to the broadcast address of the network containing the new device. This causes all devices on that physical network to see it. Other alternatives than using the broadcast address have been described.” As can be seen, this cited paragraph of Ylonen does not disclose the claimed turning off a feature to configure the first device until the first device is in an un-configured state. Ylonen’s cited paragraph of col. 9, lines 1-2 discloses that “a network device may want to disable listening for configuration packets once it has been configured,” which, as indicated in the Appeal Brief, is patentably distinguished from the claimed turning off a feature to configure the first device *until the first device is in an un-configured state* (Appeal Brief, page 10, section b), first paragraph).

Point (C), page 10, 5th paragraph

On page 10, 5th paragraph, the Examiner’s Answer asserted that “the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so *found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art*” (emphasis added). The Examiner’s Answer then continued “[i]n this case, Philippou is related to device initializing over a network, Ylonen is related to a [sic] network devices and device installation. Philippou and Ylonen are in the same field of endeavor.” While the Examiner’s Answer correctly recited the relevant law, the Examiner’s Answer failed to apply the law to the facts of the case. The Examiner’s Answer *failed to show some teaching, suggestion, or motivation in Philippou or Ylonen* to combine or modify the teachings of Philippou or Ylonen. In fact, there is no teaching or suggestion in Philippou or Ylonen to combine or modify the teaching of Philippou or Ylonen to produce the claimed invention. The Examiner’s Answer also *failed to show it is in the knowledge generally available to one of ordinary skill in the art* that teaches, suggests, or motivates to combine or modify the teachings of Philippou and Ylonen. The statement in the Examiner’s Answer that Philippou is related to device initialization over a network; Ylonen is related to a network device and device installation; and Philippou and Ylonen are in the same field of endeavor does not show any teaching, suggestion, or motivation in Philippou or Ylonen to combine or modify the teachings of Philippou or Ylonen. Such statement

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in the Examiner's Answer does not show it is in the knowledge generally available to one of ordinary skill in the art that teaches, suggests, or motivates to combine or modify the teachings of Philippou and Ylonen, either.

Claims 2, 18, and 21

On page 11, 2nd paragraph regarding point (D), the Examiner's Answer asserted that "... Philippou teaches of [sic] a box, which can be a computer system, which contains a processor. The processor, which is the first device, is embedded in the box, . . ."

As indicated in the discussion related to claims 1, 16 and 19, this is the first time Philippou's processor was corresponded to the claimed first device. Further, it is respectfully submitted that the claimed first device (that provides console capabilities to the second device) is patentably distinguished from Philippou's processor. Additionally, as indicated in the Appeal Brief, page 2, 3rd paragraph to page 3, 1st paragraph, the claimed first device that provides console capabilities to the second device is patentably distinguished from Philippou's network interface or the network interface that provides console capabilities.

Claim 3

Regarding point (E), the Examiner's Answer did not respond to the discussion in the Appeal Brief, page 13, 3rd paragraph, which stated "Philippou's table 4 is a display of the boxes found after configuring utility 231 receives the acknowledgement from box 205, which is patentably distinguished from the claimed table in which the first parameter is sent to this table and, from this table, the first parameter is obtained so that it can be configured to the first device." However, the Examiner's Answer asserted "Philippou teaches the table stores information on the boxes in the system and allows an administrator to input information into the table which is also to be sent to the box (figure 4, 401, column 5, lines 26-44)." As discussed in the Appeal Brief, and it is hereby resubmitted that Philippou's table 4 is a display of the boxes found after configuration utility 231 receives the acknowledgement from box 205, which is patentably distinguished from the claimed table in which the first parameter is sent to this table and, from this table, the first parameter is obtained so that it can be configured to the first device.

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Claims 5, 17, and 20

It is noted that this is the first time Ylonen's paragraph of col. 3, line 64 to col. 4, line 1 (Examiner's Answer, page 11, point (F), near the bottom of the page) was used to reject claims 5, 17, and 20. In any event, this cited paragraph of Ylonen, even though discloses "it should be understood generally as something that can be used to identify a network device," does not specifically disclose the claim that "the device's identifier is *a media access control address of the first device*" (emphasis added).

Claim 6

On page 12, 3rd paragraph regarding point (G), the Examiner's Answer asserted that "Philippou teaches of [sic] a processor in a box receives a parameter and processes the parameter once acquired (column 5, lines 57-65). The limitation upon identifying the device's identifier on the communication channel was not disclosed in the claim and was not considered." As indicated above in the discussion related to claim 1, the claimed first device is patentably distinguished from Philippou's processor. Further, claim 6 depending from claim 1 that recites "acquiring the first parameter upon identifying the device's identifier on the communication channel." As a result, the limitation *upon identifying the device's identifier on the communication channel* in claim 1 is incorporated into claim 6, which is contrary to the assertion that this limitation "was not disclosed in the claim."

Claim 7

On page 12, regarding claim 7, point (H), the Examiner's Answer asserted that "Philippou teaches of [sic] a box, and then the box allows the processor to acquire the parameter via a bus (Figure 3, 301, column 3, lines 49-53, and column 4, lines 44-49)."

It is noted that this is the first time this assertion of the Examiner's Answer was raised in rejecting claim 7 because claim 7 was rejected on different grounds in both the Final Office Action and the Advisory. In any event, the steps of the second device obtaining the first parameter, and acquiring the first parameter from the second device is patentably distinguished from the assertion because, reading together with claim 1 from which claim 7 depends, the claimed first device is to

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be configured with a parameter, is embedded in the second device, and provides administrative capabilities to this second device whereas Philippou does not disclose that the processor is to be configured with a parameter.

Claim 9

On page 13, 2nd paragraph regarding point (I), the Examiner's Answer asserted that "Philippou teaches of [sic] a typical computer system which includes a bus . . ." Here, the claimed second device is patentably distinguished from Philippou's computer system because the claimed second device embeds the claimed first device which, among other things, is to be configured with a parameter whereas Philippou does not disclose that that computer embeds any device to be configured with a parameter.

Claim 10

None of the cited paragraphs in the Examiner's Answer, page 10, point (J), middle of the page, discloses that the device's identifier is an internet protocol address, a media access control address, or an asynchronous transfer mode address, etc. Additionally, none of those paragraphs discloses that these addresses are of *the claimed second device* that embeds the first device to be configured with a parameter.

Claim 4

On page 14, 2nd paragraph, point (K), the Examiner's Answer asserted that "[i]t is well known in the art that and [sic] address resolution protocol command is used to send to a table and a packet internet groper protocol command is able to obtain from a table. Ylonen further teaches a device may obtain its IP address automatically from the network using various methods; use an address resolution protocol to send IP addresses to a device (column 4, lines 35-42), and a ping packet can be used to configured a device remotely (column 2, lines 36-41)."

It is noted that it is the first time that Ylonen's paragraphs of col. 4, lines 35-42 and col. 2, lines 36-41 were cited to reject claim 4. Further, the Examiner's Answer failed to provide evidence supporting the assertion that it is well known in the art that an address resolution protocol command is used to send to a table and a packet internet groper protocol command is able

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to obtain from a table. In any event, the newly cited paragraphs of Ylonen do not disclose the claim that an address resolution protocol command sends the claimed first parameter (in the form of an IP address) to the table and a packet internet groper protocol obtains the claimed first parameter from the table.

Claims 12, 22

On page 14, 4th paragraph regarding point (L), the Examiner's Answer asserted that "Ylonen teaches it is desirable to provide a method and apparatus for loading configuration data into a network device in a reliable, easy-to-use manner from a network management station (column 2, lines 58-63) to prevent attacks on a network (column 3, lines 3-7)." Here, the Examiner's Answer only recited what is disclosed in Ylonen, and, like the Final Office Action, the Examiner's Answer *failed to show any teaching or suggestion in either Philippou or Ylonen to combine or the teachings of Philippou and Ylonen*. In fact, there is not any of such teaching or suggestion. The Examiner's Answer also failed to show it is of general knowledge to combine or modify the two teachings, either.

Claims 13, 23

On page 15, 2nd paragraph, regarding point (M), the Examiner's Answer asserted that "[t]he command in the packet is the information for setting up a shared secret, which is processed by the processor embedded in the box." As discussed above, the claimed first device is patentably distinguished from Ylonen's processor. Therefore, the claimed that the command being executed in the first device is patentably distinguished from Ylonen's information which is processed by the processor. The assertion in the Examiner's Answer that "Ylonen teaches it is desirable to provide a method and apparatus for loading configuration data into a network device in a reliable, easy-to-use manner from a network management station" does not show any teaching or suggestion to combine the two teachings. The assertion is a conclusory statement that relies on hindsight, which is impermissible.

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Claim 14

On page 15, last paragraph regarding point (N), the Examiner's Answer's response to claim 14 is similar to that of claim 12, 22. Please refer to the discussion related to claim 12, 22.

Claim 15

On page 16, 2nd paragraph, point (O), the Examiner's Answer asserted the assertion of claim 1 point (B) and of claim 2. Please refer to the discussion for claim 1 point (B) and claim 2.

In brief, claim 15 is patentable for at least the following reasons. The claimed feature turning-off a feature to configure the first device until the first device is in an un-configured state is patentably distinguished from Ylonen teaching whether the device authentication is negative or positive or reading the device identifiers from the received packets until it receives its own configuration message as asserted by the Examiner's Answer. Additionally, the claimed first device is patentably distinguished from Philippou's processor.

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II. CONCLUSION

For the reasons set forth in the Appeal Brief submitted on November 7, 2005, and as supplemented by the above remarks, Appellants respectfully submit that claims 1, 16, 19; 2, 18, 21; 3, 5, 17, 20; 6; 7; 9; 10; 4; 12, 22; 13, 23; 14; and 25 are patentable. Reversal of the rejections is courteously requested.

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